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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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Kan'ichi Sato

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EXAMINER

CHENEVERT, PAUL A

ART UNIT

PAPER NUMBER

3612

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|-------------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/559,978 | SATO, KAN'ICHI | |
| | Examiner | Art Unit | |
| | Paul A. Chenevert | 3612 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. PCT/JP2004/008275.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2005 12 08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 11JUN03. It is noted that applicant has filed a certified copy of the Japanese application 2003-166687 in the international application PCT/JP2004/008275 on 24JUN04 as stated in the PCT/IB/301 mailed 28JUL04.

Drawings

2. The drawings are objected to because of the following minor informalities:
- a. In Figure 8 (seventh embodiment), the upper surface of the outer layer (16) and the sound absorbing foaming layer (15) should extend to the outer plate (11) as is properly done in Figure 2. It appears that the top portion of the image from Figure 7 (sixth embodiment) was erroneously added to the image in Figure 8 (i.e. the top longitudinal member (12) is exposed). Please note that the bottom of Figure 8 is proper.
 - b. In Figure 11(b), the air vent (30'') is not shown on the backside image. It is thought that Figure 11(b) should be redrawn with a new rectangular opening showing the missing air vent (30'') as is properly done for air vents (30 & 30').
 - c. Reference number 15a should be changed to 15 in Figure 12(c) because reference number 15a designates the cavity and reference number 15 designates the actual sound absorbing foaming layer.

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- d. Figure 14 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:
 - a. Page 13, line 23, “nylon” should be changed to “thermoplastic polyamide such as NYLON” since nylon was coined by DuPont in 1938 and is currently trademarked under many various products.
 - b. Page 21, line 19, “third embodiment” should be change to “fourth embodiment”.

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- c. Page 27, line 8, "first embodiment" should be change to "sixth embodiment".
- d. Page 28, line 21, "Fig 10(b)" should be changed to "Fig 11(b)".

Appropriate correction is required.

Claim Objections

- 4. Claim 14 is objected to because of the following informalities: on line 3, "an outer plate portion inside of which the interior member is placed is formed" should be changed to "an outer plate portion, inside of which the interior member is placed, is formed"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

- 6. Claims 8, 9 & 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: it is unclear how the foundation body panel (14) is made of a polyurethane resin that is not foamed or that is enlarged

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through foaming". It is either foamed or it is not foamed, but is cannot be both foamed and not foamed.

b. The term "semi-hard" in claim 9 is a relative term which renders the claim indefinite. The term "semi-hard" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

c. Claim 13 recites the limitation "the sound absorbing member" on line 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear how this sound absorbing member is different from the sound absorbing material/member earlier introduced in the depended upon claims 1 or 2. It is thought that the sound absorbing material of claim 1 represents the sound absorbing foaming layer (15) shown in the 1st, 2nd, 4th, 6th, 7th and 9th embodiments. It is thought that the sound absorbing member of claim 2 represents the sound absorbing foaming layer (20) shown in the 2nd, 3rd, 4th, 5th, 7th and 8th embodiments. It is further thought that the sound absorbing member of claim 13 represents the sound absorbing layer (26) shown in the 9th embodiment.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 4-7 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Beulat.

Beaulat discloses an interior member (covering panel 2) mounted on a door (1) for a cab of an automobile, characterized in that a sound absorbing material (column 4, lines 16-21) is contained between an outer layer material (second panel 3b) and a foundation body panel (first panel 3a). In regards to claim 4, the interior member includes a duct (cavity 5) for attaching wire (electrical cables 5a). In regards to claim 5, a metal plate (3a) is placed on an end surface of a side of the foundation body panel. In regards to claim 6, the foundation body panel is manufactured from a material having heat insulating properties and the interior member includes an air conditioning duct (cavity 4). In regards to claim 7, the foundation body panel is connected to the door by a fastener (glue 7). In regards to claim 10, the thickness of the sound absorbing material is within 5mm to 20 mm thick.

9. Claims 2 & 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Tokunaga et al.

Tokunaga et al. disclose an interior member mounted on a dashboard (13) for a cab of an automobile, characterized in that a sound absorbing material (14) is contained inside a foundation body panel (10). In regards to claim 3, the foundation body panel comprises crossed ribs (12) on the rear surface side.

10. Claim 13, as understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Leadbetter.

Leadbetter discloses a wall member for a cab of an automobile, which comprises an interior member including a sound absorbing material (34) contained between an outer layer (30) and a foundation body panel (35), characterized in that another sound absorbing member (27) is charged between a plate (26) that is placed on an end surface of a side of the foundation body

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panel of the interior member and an outer plate (29) having sound blocking properties (inherent property of vehicle outer panels).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 8 & 9, as understood, and claim 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokunaga et al. in view of obvious common knowledge.

Tokunaga et al. disclose an interior member comprising a sound absorbing material.

Tokunaga et al. disclose the claimed invention except for the sound absorbing material being made of a polyurethane resin that is enlarged through foaming (claim 8), of a semi-hard polyurethane (claim 9), or of a polyurethane foam (claim 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ polyurethane foams, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious mechanical expedient choice. *In re Leshin*, 125 USPQ 416.

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beaulat in view of obvious common knowledge.

Beaulat discloses the claimed invention except for the sound absorbing material being made of a foaming resin member. It would have been obvious to one having ordinary skill in the

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art at the time the invention was made to employ foaming resins, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious mechanical expedient choice. *In re Leshin*, 125 USPQ 416.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beaulat in view of obvious common knowledge.

Beaulat discloses a wall member (door 1), which includes an interior member, characterized in that an outer plate portion (rubbing strips 1c) having an outer layer (exterior surface of the rubbing strips) outside of a metal plate (inner skin 1b).

Beaulat discloses the claimed invention except for the outer plate portion being made of a polyurethane resin layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a polyurethane resin layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious mechanical expedient choice. *In re Leshin*, 125 USPQ 416.

15. Claims 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaulat in view of obvious common knowledge.

Beaulat discloses an interior member as described above. However, Beaulat does not expressly disclose all methods of forming the interior member

It has also been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to manufacture the interior member of Beaulat by mutli-step molding processes.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Chenevert whose telephone number is 571-272-6657. The examiner can normally be reached on Mon-Fri (8:30-5:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PAC

Paul A. Chenevert
Examiner
Art Unit 3612

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2/20/07